

REMARKS

Claims 39 through 68 were presented for examination in the present application. The instant Amendment cancels claims 43 and 59 and, thus, claims 39 through 42, 44 through 58, and 60 through 68 are presented for consideration upon entry of the instant Amendment, which is respectfully requested.

Independent claim 39 was amended to include the elements of dependent claim 43. Similarly, independent claim 56 was amended to include the elements of dependent claim 59. Rendering the rejection to original independent claims 39 and 56 moot.

Claims 43 and 59, the elements of which are now incorporated into independent claims 39 and 56, respectively, were rejected under 35 U.S.C. §103 over U.S. Patent No. 4,917,495 to Steenhoek (Steenhoek) in view of U.S. Patent No. 5,268,749 to Weber.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that there is no motivation to combine the teachings of Steenhoek and Weber. Specifically, it is respectfully submitted that the proposed modification of Steenhoek with the disclosure of Weber would render the disclosure of Steenhoek unsatisfactory for its intended purpose.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Steenhoek discloses that "the main object of the present invention is to provide a portable compact colorimeter and a method for characterizing a colored surface in particular a colored surface containing metallic or pearlescent particles, which employs three illumination angles and one detection angle." See col. 2, lines 50-56. Thus, Steenhoek discloses the need for three illumination angles.

As asserted by the Office Action, Weber provides an apparatus for providing uniform illumination. See page 3, line 20 through page 4, line 3 of the Office Action dated May 4, 2005.

It is respectfully submitted that modification of the "three illumination angles" of Steenhoek with the "uniform illumination" of Weber would render Steenhoek unsatisfactory for its intended purpose. Specifically, uniform illumination is contrary to and is taught away from by the "three illumination angles" of Steenhoek.

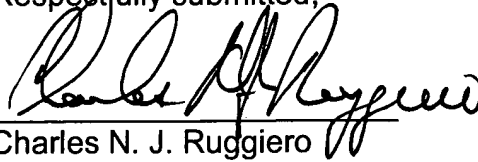
Therefore, it is respectfully submitted that there is simply no motivation to combine Steenhoek and Weber in the manner suggested by the Office Action. As such, amended independent claims 39 and 56, as well as claims 40 through 42, 44 through 55, 57 through 58, and 60 through 64 that depend therefrom, are believed to be in condition for allowance. Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the above, it is respectfully submitted that the present application is in condition for allowance. Such action is solicited.

In the alternative, it is believed that the instant amendment places the present application in better condition for appeal. Accordingly, entry and consideration of the instant amendment is respectfully requested.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charles N. J. Ruggiero", written over a horizontal line.

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